

RESPONSE AFTER FINAL REJECTION
REMARKS

Applicant thanks the examiner for identifying allowable subject matter in claims 9-11 of the present application.

Applicant acknowledges the objection to the drawings and will submit formal drawings upon allowance of the claims.

In the office action, all claims have been rejected as either being anticipated or rendered obvious by U.S. Published Patent Application No. 2003/0078763 A1, to Chuang et al. ("Chuang"). The Chuang reference was the subject of a Declaration Pursuant to 37 C.F.R. 1.131, filed on December 4, 2004, which the examiner has alleged to be defective. In view of the Supplemental Declaration of Ken Shepard, the inventor of the above referenced application, and the remarks set forth below, applicants respectfully urge that the pending claims are patentable over the art of record.

Applicants hereby submit a supplementary declaration under 37 C.F.R. § 1.131 of the inventor, Dr. Kenneth Shepard, demonstrating actual reduction to practice of the present invention and due diligence prior to the April 19, 1999, filing date of U.S. Published Patent Application No. 2003/0078763 A1, to Chuang et al. ("Chuang"), and supplementing Applicants' responses to questions (a) and (e) of the Examiner's Requirement for Information Under Section 1.105 concerning the authorship of an academic paper submitted with the declaration and the inventive role Dr. Shepard's graduate student, Dae-Jin Kim, respectively.

Applicants respectfully submit that, in view of the enclosed supplementary declaration of Dr. Shepard under 37 C.F.R. § 1.131, the Chuang reference is not prior art

RESPONSE AFTER FINAL REJECTION

under 35 U.S.C. § 102(e), and the rejection of pending claims 1-8 and 12-22 should be withdrawn.

Pending claims 1-8 and 12-22 stand rejected as anticipated by Chuang (claims 1-4 and 16-17) or rendered obvious by Chuang in view of Dr. Shepard's own publications (claims 5-8, 12-15 and 19-22), notwithstanding Applicants' Declaration Under 37 C.F.R. § 1.131 by Dr. Shepard, mailed on December 4, 2003, that shows conception and reduction to practice prior to the filing date of Chuang and Applicants' responses, mailed on June 24, 2004, to questions (a)-(g) in the Examiner's Requirement for Information Under 37 C.F.R. § 1.105 mailed on February 24, 2004.

In the Final Office Action dated September 30, 2004, the Examiner maintained the rejection of claims 1-8 and 12-22, arguing that the two exhibits accompanying Dr. Shepard's Section 1.131 declaration--copies of a paper co-authored by Dr. Shepard and Mr. Kim submitted to the International Conference on Computer Aided Design (ICCAD) on April 9, 1999, and a presentation, also co-authored by Mr. Kim and Dr. Shepard, given on February 8, 1999 by Dr. Shepard--though providing evidence of conception prior to the critical date of the Chuang reference, April 19, 1999, do not "provide evidence of actual reduction to practice and due diligence" prior to the critical date.

In the Final Office Action, the Examiner further acknowledged that Applicants' responses to questions (c)-(d), (f) and (g) of the Requirement to Submit Information Under Section 1.105 were persuasive. The Examiner however deemed unpersuasive Applicants' responses to questions (a) and (e), concerning the absence of any inventive role by Mr. Kim in the present application, notwithstanding his inclusion as

RESPONSE AFTER FINAL REJECTION

a co-author in the ICCAD 99 paper,¹ the February 8, 1999, presentation and a June 2000 conference paper, on the ground that “attorney arguments” are not sufficient in situations where “[f]acts not conclusions must be alleged.”

Applicants assert that the supplemental declaration under Section 1.131 by Dr. Shepard now clearly demonstrates that the exhibits accompanying the original declaration and subsequent response to the Requirement to Submit Information Under Section 1.105 indeed prove actual reduction to practice and diligence prior to the critical date of the Chuang reference. This supplemental declaration also provides sufficient evidence answering questions (a) and (e) of the Examiner’s Requirement to Submit Information Under Section 1.105, concerning the authorship of an academic paper submitted with the original declaration, as Exhibit A, and establishes that Mr. Kim’s role was that of a co-author on a number of academic papers and a presentation but not that of an inventor of the claimed subject matter.

In view of evidence submitted by the Applicant, it is respectfully submitted that the Chuang reference is not applicable prior art to the present claims. As such, the present claims are allowable.

CONCLUSION

Applicant respectfully submits that the above constitutes a candid and good faith response to the Office communication mailed on September 30, 2004. In the event that any additional information is deemed necessary, Applicant's attorneys are

¹ Applicants note that there are, in fact, several differences between the as-submitted ICCAD 99 paper (Exhibit A, November 15, 2003, Declaration Pursuant to Section 1.105) and the as-published version (Exhibit 1, Response to Requirement to Submit Information Under Section 1.105), notwithstanding Applicants’ earlier statement that these papers are “substantially identical” except for the inclusion of the authors’ names. The as-published paper is somewhat longer and includes figures not found in the as-submitted paper. Since Applicants rely on the April 9, 1999, submission, and not the as-published version, to demonstrate actual reduction to practice and due diligence, these differences are immaterial.

RESPONSE AFTER FINAL REJECTION

available to participate in a telephone conference with the Examiner on the number given below.

Respectfully submitted,



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Enclosure